

REMARKS

Claims 1, 2, 10, 12, 13, 18, 19 and 20 are objected to and stand rejected under 35 U.S.C. § 112, second paragraph. The examiner urges that the recitation of "about" as used in the claims (*at least about, below about, and above about*) is indefinite because it is not clear where the upper and lower bounds of the limitations lie exactly. Applicants respectfully disagree.

Accompanying this response is a page from the MPEP stating that the term "about" is clear but flexible. While the phase *at least about* may be indefinite in circumstances where close prior art exist, such close prior art has not been applied in the subject application. Reconsideration and withdrawal is requested.

Claims 1-4 and 6-10 and 12-15 are rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 5,631, 079 (Gutman et al.).

Applicants' disagree.

Gutman discloses a pressure sensitive adhesive tape comprising a substrate having coated thereon an acrylic microparticle adhesive. The adhesive is adhered to the substrate by a primer. The examiner urges that the primer, which contains at least one phenolic resin and at least one rubbery component, serves as a binder for the acrylic microparticles. The examiner notes that the rubbery compound may be a mixture of e.g., acrylonitrile-butadiene-styrene copolymers (ABS) and polychoroprene and urges that these components have Tgs of >100°C and -46°C, respectively.

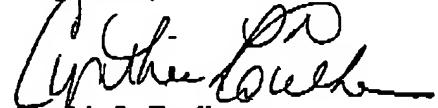
The disclosure of Gutman does not anticipate applicants' claimed invention.

Applicants are claiming an adhesive comprising acrylic microspheres and a binder component. The binder component comprises a first binder and a second binder, the first and second binders having glass transition temperatures, Tgs, separated by at least about 20°C. Gutman does not disclose or suggest an adhesive comprising at least two binders having Tgs separated by at least 20°C one or more binders. The adhesive of Gutman is coated onto a primer that comprises both a phenolic resin and at least one rubbery component. There is no disclosure or suggestion that the rubbery component of the primer may be used as a binder in the preparation of the adhesive component.

The claimed invention is not anticipated by Gutman. Furthermore, the claimed invention would not be obvious to one skilled in the art from the disclosure of Gutman. Reconsideration and withdrawal is requested.

Early and favorable action is solicited.

Respectfully submitted,



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March 3, 2004

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2173.05(b)

## MANUAL OF PATENT EXAMINING PROCEDURE

REFERENCE TO AN OBJECT THAT IS VARIABLE  
MAY RENDER A CLAIM INDEFINITE

A claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. *Ex parte Brummer*, 12 USPQ2d 1653 (Bd. Pat. App. & Inter. 1989). On the other hand, a claim limitation specifying that a certain part of a pediatric wheelchair be "so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats" was held to be definite. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). The court stated that the phrase "so dimensioned" is as accurate as the subject matter permits, noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

## A. "About"

The term "about" used to define the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible. *Ex parte Eastwood*, 163 USPQ 316 (Bd. App. 1968). Similarly, in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as "exceeding about 10% per second" is definite because infringement could clearly be assessed through the use of a stopwatch. However, the court held that claims reciting "at least about" were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term "about." *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).

## B. "Essentially"

The phrase "a silicon dioxide source that is essentially free of alkali metal" was held to be definite because the specification contained guidelines and examples that were considered sufficient to enable a person of ordinary skill in the art to draw a line between unavoidable impurities in starting materials and essential ingredients. *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (CCPA 1983). The court further observed that it would be impractical to require appli-

cants to specify a particular number as a cutoff between their invention and the prior art.

## C. "Similar"

The term "similar" in the preamble of a claim that was directed to a nozzle "for high-pressure cleaning units or similar apparatus" was held to be indefinite since it was not clear what applicant intended to cover by the recitation "similar" apparatus. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

A claim in a design patent application which read: "The ornamental design for a feed bunk or similar structure as shown and described." was held to be indefinite because it was unclear from the specification what applicant intended to cover by the recitation of "similar structure." *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

## D. "Substantially"

The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

## E. "Type"

The addition of the word "type" to an otherwise definite expression (e.g., Friedel-Crafts catalyst) extends the scope of the expression so as to render it indefinite. *Ex parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955). Likewise, the phrase "ZSM-5-type aluminosilicate zeolites" was held to be indefinite because it was unclear what "type" was intended to convey. The interpretation was made more difficult by the fact that the zeolites defined in the dependent claims were not within the genus of the type of zeolites defined in the independent claim. *Ex parte Attig*, 7 USPQ2d 1092 (Bd. Pat. App. & Inter. 1986).

## F. Other Terms

The phrases "relatively shallow," "of the order of," "the order of about 5mm," and "substantial portion" were held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second